

REMARKS

Claims 1-5 are pending. In the final Office Action, claim 1 was rejected under 35 USC 103(a) as unpatentable over Lew et al. (WO 92/17951) in view of Borazjani et al. (U.S. 5,825,829). Claim 2 was rejected under 35 USC 103(a) as unpatentable over Lew in view of Borazjani and Yen et al. (U.S. 4,707,841). Claim 3 was rejected under 35 USC 103(a) as unpatentable over Lew in view of Borazjani and Menkhoff et al. (U.S. 6,137,349). Claim 4 was rejected under 35 USC 103(a) as unpatentable over Lew in view of Borazjani and Ley et al. (U.S. 6,594,613). Claim 5 was rejected under 35 USC 103(a) as unpatentable over Lew in view of Borazjani, Ley, and Camp et al. (U.S. 5,592,517). Applicant respectfully traverses the rejections for the following reasons.

To establish prima facie obviousness, the references must teach every limitation of the claimed invention. In addition, there must be some suggestion or motivation, in the references themselves or in the knowledge available to one of ordinary skill in the art, to combine reference teachings with a reasonable expectation of success. MPEP 2143. There are three possible sources for a motivation to combine references: the nature of the problem to be solved; the teachings of the prior art; and the knowledge of persons of ordinary skill in the art. MPEP 2143.01.

Claim 1 recites forming digital auxiliary signals by sampling digital input signals with a post processing clock, which is generated by a single resampling device 11. In paragraph 3 of the pending Office Action, the Examiner states that Borazjani discloses a single resampling device (block 120). Applicant respectfully disagrees.

In Borazjani, no resampling takes place in interpolation filters 120. Rather, according to column 21, lines 1-12, an interpolation technique is carried out for each digital input signal, in which the data rate of the digital input signals is increased by a factor of 8. Thereafter, through a simple sample repetition technique, the data rate is increased again by a factor of 2. Altogether, then, the data rate is increased by a factor of 16 through interpolation or repetition of data values. No resampling takes place in interpolation filters 120. Rather, data rate is increased by the interpolation filters to introduce additional interpolated data values. No synchronization of Borazjani's input signals can be achieved, because the sampling rate of Borazjani's output data depends on the data rate at which the input signal is present at its respective interpolation filter 120.

Further, Barazjani's interpolation filters 120 cannot be a single resampling device because, as stated in column 20, lines 55-56, the interpolation filters are a set of twelve individual filters. Twelve individual interpolation filters do not equate to a single resampling device. Still further, Barazjani's interpolation filters are not controlled by a common post-processing clock.

Similarly, none of the other cited prior art discloses forming digital auxiliary signals by sampling digital input signals with a post processing clock, which is generated by a single resampling device. Because all of the limitations in claim 1 are not taught or suggested in the prior art, a prima facie case of obviousness has not been established for claim 1. Thus, the rejection of claim 1 under section 103 has been overcome and should be withdrawn. Claims 2-5 depend from claim 1 and are therefore allowable for at least the same reasons.

In paragraph 3 of the pending Office Action, the Examiner states that Borazjani et al. is in the same field of endeavor as Lew, and that one skilled in the art would combine Borazjani's resampler with Lew's system to reduce size and cost, and to produce the desired signals. Applicants respectfully disagree. Despite the Examiner's assertion that these two references are in the same field of endeavor, their fields of endeavor are distinct. Lew is directed to synchronization of digital audio signals, while Borazjani is directed to a modulator in a communication system for the transmission of telephone signals in a cable television network.

The Examiner has not asserted that motivation to combine derives from either the nature of a problem to be solved or the teachings of the prior art, and therefore relies on the knowledge of one of ordinary skill in the art. However, one of ordinary skill in the art would not look to the teaching of Borazjani when working in Lew's field of synchronizing digital audio signals. Thus, there is no motivation to combine the references, and certainly no reasonable expectation of success.

The Examiner's stated motivations, including reduced size and cost, are impermissibly based on hindsight. Further, these conclusory statements made by the Examiner fail to provide the substantial evidence required to support an obviousness rejection, because they are so general in the context of the relevant art as to constitute no more than the reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Under *Lee*, the Examiner must present *specific* evidence of motivation, not the kind of generalized allegation of motivation relied on in the pending Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002, 2007 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ’237 patent, col. 4, ll. 34-38.

The reliance in the pending Action on the alleged routine skill in the art to reduce size and cost comes nowhere close to what *Lee* and *Thrift* require. It is not sufficient to say without evidentiary support, as the Examiner does in the pending Action, that one skilled in the art would combine Borazjani’s resampler with Lew’s system to reduce size and cost, and to produce the desired signals. The Examiner has pointed to no disclosure in either reference that would have motivated a person of ordinary skill in the art to use its supposed paper-supplying tray design so as to arrive the claimed invention. Applicant’s invention may be a straightforward and elegant solution to the problem it addresses, but the cited prior art is devoid of a suggestion to make it.

Accordingly, the invention as claimed is patentable over the prior art, and claim 1 should be allowed.

Even if one of ordinary skill in the art were to combine the publications of Lew and Borazjani, they would merely obtain a system where the data rate of digital input signals was increased by individual interpolation filters, which is fundamentally different than the method recited in claim 1.

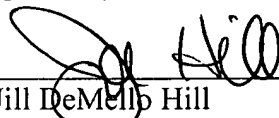
With respect to the Examiner's rejection of claim 4, Applicant notes that claim 4 recites the digital input signals being obtained from secondary variables of measuring transducers in an electric power supply system. Ley et al., to the contrary, is directed to monitoring liquids in a processing plant.

In view of the above, each of the pending claims is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **Attorney Docket No. 449122006400**.

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Respectfully submitted,

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